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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/17/1999

KARL ERIK STAHL

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7590

09/21/2005

STAAS & HALSEY LLP

SUITE 700

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WASHINGTON, DC 20005

EXAMINER

DUONG, DUC T

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/397,959	<b>Applicant(s)</b> STAHL, KARL ERIK	
	<b>Examiner</b> Duc T. Duong	<b>Art Unit</b> 2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/26/05.                      6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (U.S. Patent 6,934,258 B1).

Regarding to claims 1 and 4, Smith discloses a telecommunication apparatus 30 for initiating and receiving voice and data (fig. 1-2 col. 4 lines 63-67) comprising a first port 242 (PSTN I/O) to connect said apparatus to a PSTN network 18 (fig. 1-2 col. 7 lines 17-20), a second port 242 (IP I/O) to connect said apparatus to an IP network 14 (fig. 1-2 col. 7 lines 17-20), and a gateway means 230 for establishing a path between

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said first port (PSTN I/O) and said second port (IP I/O) inside said apparatus in response to a request from a remote unit 36 on the IP network 14 acting on behalf a caller 34 (fig 1-2 col. 7 lines 33-37; noted when the quality of service QOS of a call changed the transport control unit 230 switched the call on the IP 14 to PSTN 18 or vice versa in response to the remote unit 36 request, and thus a path is established between the IP I/O and the PSTN I/O), whereby said telecommunication apparatus 30 can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication network 18 and said packet based telecommunication network 14 (fig. 1-2; the PBX system 30 serve as a distributed gateway system connecting to both the PSTN 18 and IP 14 networks).

Regarding to claim 2, Smith discloses a third port 242 (handset I/O) to connect a conventional telephone apparatus 32 via said telecommunication apparatus 30 to said first port (fig. 1-2 col. 4 lines 44-53).

Regarding to claim 5, Smith discloses gateway location servers 450 connected to said IP network 430, said gateway location servers 450 being adapted to receive a request from a first telecommunication apparatus 410 connected to said packet IP network 430 for telecommunication with a specified telephone apparatus on said PSTN network 440, and further being programmed to select a second of said telecommunication apparatuses 420 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus 420 via IP network 430 (fig. 4 col. 8 lines 48-64).

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Regarding to claims 6 and 7, Smith discloses the packet based telecommunication network comprises the Internet (fig. 1 col. 4 lines 19-21).

Regarding to claim 8, Smith discloses a telecommunication apparatus 30 for initiating and receiving voice and data (fig. 1-2 col. 4 lines 63-67) comprising a first port 242 (PSTN I/O) to connect said apparatus to a PSTN network 18 (fig. 1-2 col. 7 lines 17-20), a second port 242 (IP I/O) to connect said apparatus to an IP network 14 (fig. 1-2 col. 7 lines 17-20), and a gateway means 230 for establishing a path between said first port (PSTN I/O) and said second port (IP I/O) inside said apparatus in response to a request from a remote unit 36 on the IP network 14 (fig 1-2 col. 7 lines 33-37; noted when the quality of service QOS of a call changed the transport control unit 230 switched the call on the IP 14 to PSTN 18 or vice versa in response to the remote unit 36 request, and thus a path is established between the IP I/O and the PSTN I/O); and gateway location servers 450 connected to said IP network 430, said gateway location servers 450 being adapted to receive a request from a first telecommunication apparatus 410 connected to said packet IP network 430 for telecommunication with a specified telephone apparatus on said PSTN network 440, and further being programmed to select a second of said telecommunication apparatuses 420 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus 420 via IP network 430 (fig. 4 col. 8 lines 48-64), whereby said telecommunication apparatus 30 can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN)

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between said circuit switched telecommunication network 18 and said packet based telecommunication network 14 (fig. 1-2; the PBX system 30 serve as a distributed gateway system connecting to both the PSTN 18 and IP 14 networks).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Chan et al (U.S. Patent 6,711,160 B2).

Regarding to claim 3, Smith discloses all the limitations with respect to claim 2, except for a mechanism to automatically connect said third port directly to said first port in the event of power failure. However, Chan discloses packet telephone system comprising a fallback switch 110 for connecting a telephone handset 111 (third port) directly to a PSTN interface 112 (first port) in the event of power failure (fig. 1 col. 6 lines 51-64). Thus, it would have been obvious to a person of ordinary skill in the art to employ a fallback switch as taught by Chan in Smith's system to provide an optional arrangement capable of making telephony connection when the packet network is inactive.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Bhattacharya et al (US Patent 6,353,610 B1).

Regarding to claim 10, Smith discloses all the limitations with respect to claim 9, except for a means for automatically notifying said gateway location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network. However, Bhattacharya discloses an internet telephony system, wherein a source gateway 100 (gateway location server) is notified of an off hook condition when the destination gateway 130 serving between the Internet 125 and the PSTN 145 detects a busy signal (fig. 1 col. 4 lines 52-61). Thus, it would have been obvious to a person of ordinary skill in the art to employ an off hook notification as taught by Bhattacharya in Smith's system to alert the subscriber of the connection status.

#### ***Allowable Subject Matter***

6. Claims 9, 11, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 571-272-3122. The examiner can normally be reached on M-F (9:00 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Q. Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DD  
DD

  
RICKYUNGO  
PRIMARY EXAMINER

8/14/05